



Patent
Atty Docket P2346-504

AF/SA
ZJW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Bas Ording et al.) Group Art Unit: 2173
Application No.: 09/467,074) Examiner: Xiomara L. Bautista
Filed: December 20, 1999) Confirmation No.: 1894
For: USER INTERFACE FOR)
PROVIDING CONSOLIDATION)
AND ACCESS)
)

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated February 9, 2005. For ease of reference, the following headings correspond to those appearing in the Examiner's Answer.

Grouping of Claims (pp 2-3)

The Answer states that all of the rejected claims stand or fall together, on the grounds that Appellants' Brief does not include a statement that they do not stand or fall together, citing 37 C.F.R. §1.192(c)(7). As discussed with the Examiner prior to the mailing of the Examiner's Answer, 37 C.F.R. §1.192 is no longer in force. It was removed via the notice appearing at 69 Fed. R. 49959, August 12, 2004, and replaced by 37 C.F.R. §41.37. This section of the rules does not contain a requirement for grouping of claims. In fact, Comment 9 appearing in the Federal Register states:

(9) The grouping of claims requirement set forth in former Rule 192(c)(7) is removed. The general purpose served by former Rule 192(c)(7) is addressed in § 41.37(c)(1)(viii). The existing grouping of claims requirement has led to many problems such as (i) Grouping of claims across multiple rejections (e.g., claims 1-9 rejected under 35 U.S.C. 102 over A while claims 10-15 are rejected under 35 U.S.C. 103 over A and the appellant states that

claims 1–15 are grouped together); (ii) Claims being grouped together but argued separately (*e.g.*, claims 1–9 rejected under 35 U.S.C. § 102 over A, the appellant groups claims 1–9 together but then argues the patentability of claims 1 and 5 separately); and (iii) examiners disagreeing with the appellant's grouping of claims.

Accordingly, the statement that all rejected claims stand or fall together is without support in the currently applicable rules. Furthermore, it is clear that Appellants do not consider all of the rejected claims to stand or fall together, as evidenced by the different groupings of claims set forth on pages 8-13 of their Brief.

Response to Argument (pp 17-24)

A. The opening portion of Appellants' argument on pages 4-5 of their Brief sets forth the criteria for a proper rejection under 35 U.S.C. §103. The gist of these criteria is that there must be a teaching or suggestion to combine references, and such teaching "must ... be found in the prior art and not based on applicant's disclosure." In responding to this portion of the Brief, the Examiner's Answer characterizes the teachings of the Selker and Carpendale references, and then concludes that a person of ordinary skill in the art would be motivated to modify Selker's user bar to include Carpendale's teaching, on the grounds that "any user would like to be able to see the other objects along the bar for further interaction." However, the Answer does not identify *any* support in *either* of the references for this statement. The rejection continues to rely upon hindsight knowledge of the Appellants' disclosure, rather than any teachings of the references themselves, as a motivation to combine them, and therefore fails to meet the established criteria for a proper rejection under 35 USC § 103.

B. Appellants' point at page 6, lines 3-19 of their Brief is that the Carpendale publication is not directed to the components of a graphical user interface, such as an icon menu. Section 11.B of the Examiner's Answer does not dispute this point.

C. In response to Appellants' continuing arguments on page 7 of their Brief that the Carpendale publication does not apply to graphical user interfaces, the Answer states "*Carpendale discloses a graphical user interface or environment for representing objects such as programs, files and options by means of icons...*" (emphasis added). Appellants

are unable to find any support in the Carpendale publication for this statement, nor does the Answer provide any. It is respectfully submitted that the Carpendale publication does not relate to the representation of objects such as programs, files and options by means of icons. Rather, it is concerned with the presentation of a large amount of *data* to a viewer. Note, for instance, its title and the first sentence under the section labeled "Introduction." In an effort to provide a nexus between the references, the Answer mischaracterizes the disclosure of the Carpendale publication. There simply is no teaching in the Carpendale publication that pertains to a graphical user interface of the type disclosed in the Selker patent.

D. One of the points made in Appellants' Brief regarding claims 5, 38 and 74 is that Selker's disclosure of the Pythagorean theorem to calculate a distance does not suggest any of the three factors recited in these claims, namely an effect width, a default height or a maximum height. In responding thereto, the Answer states that Selker illustrates an increase in a tile's size from a default height to a maximum height, "and it is also clear that the width is modified." The Answer is apparently analogizing the width of the icon in the Selker patent to the "effect width" recited in the claims. However, the term "effect width" does not refer to the width of an icon, or tile. Rather, it defines a region within a given distance of the cursor that determines which tiles will be scaled in size, i.e. the range over which the fisheye "effect" will occur. See, for example, page 18, lines 20-22 of the specification. For the reasons presented in Appellants' main Brief, the subject matter of claims 5, 38 and 74 is not suggested by the Selker patent.

I. In responding to Appellants' arguments regarding claims 128, 138 and 141, the Answer quotes selected portions of claim 128, and concludes that the Selker patent discloses the quoted subject matter. However, the Answer fails to address the remainder of the recitations appearing in the claim. When the claim is read as a whole, it is apparent that the Selker patent does not disclose its subject matter, for the reasons presented in Appellants' main Brief.

It is believed that the remaining comments appearing in the Examiner's Answer are adequately addressed in Appellants' main Brief, and therefore are not discussed further herein.

In summary, the final rejections of the claims fail to identify any teachings *in the references themselves* that would motivate a person to combine them. To the extent that the Answer attempts to establish motivation, it relies upon either hindsight knowledge of Appellants' invention, or unsupportable mischaracterization of the disclosure of the Carpendale publication.

For the reasons presented herein, as well as in Appellants' main Brief, the rejections of the claims are not properly founded in the statute and the established procedures pertaining thereto, and should be reversed.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: 
James A. LaBarre
Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620